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REMARKS/ARGUMENTS

Claims 5-16 and 21-22 remain in this application. Claims 1-4 and 17-20 have been cancelled without prejudice to effect an election in response to a restriction requirement. In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 1-4 and 17-20 in a divisional application.

1. Claims 5-10 and 13-16 stand rejected as being anticipated under 35 USC 102(b) based on Zybko et al. (USP 4,680,209). The examiner asserts that the tiles of the '209 patent "inherently possess the instantly claimed rolled up properties since the tiles have the same structure that is instantly claimed." The examiner supports that assertion by citing column 3, lines 58-62:

FIG. 2 shows a carpet tile B having a bottom surface 60 on which are arranged adhesive portions 30 and 40 in a second predetermined geometrical pattern which is complimentary to the first pattern of the carpet tile A, as will be described below.

and also by citing column 5, lines 5-7:

The present invention can be practiced with carpet tiles of virtually any construction. For example, carpet tiles having polyvinyl chloride, ethylene vinyl acetate, ...

But neither citation supports the examiner's assertion that "the tiles have the same structure that is instantly claimed." By contrast, claim 5 of the present application recites:

A floor mat, comprising:
a seamless user surface layer material; and
a cushion layer material bonded to said seamless user surface layer material, wherein the cushion layer material is segmented.

Neither citation of the '209 patent discloses or suggests "a seamless user surface layer material." Moreover, neither citation of the '209 patent discloses or suggests "a cushion layer material bonded to said seamless user surface layer material, wherein the cushion layer material is segmented." Therefore, the examiner has failed to meet the burden imposed by MPEP 2112 with respect to claim 5 because the examiner has failed to present evidence or reasoning tending

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to show inherency. Claims 6-10 ultimately depend upon claim 5, and the same analysis applies to them.

Claim 13 of the present application recites:

A floor mat, comprising:
a seamless user surface layer material; and
a cushion layer material bonded to said seamless user surface layer material, wherein said cushion layer material is segmented;
wherein the floor mat is capable of being rolled into a roughly spiral configuration such that damages to the user surface layer material due to the tensile and compression forces on said seamless user surface layer material are minimal.

The above analysis applies equally to the first two elements of claim 13.

In addition, neither citation of the '209 patent discloses or suggests "wherein the floor mat is capable of being rolled into a roughly spiral configuration such that damages to the user surface layer material due to the tensile and compression forces on said seamless user surface layer material are minimal." Therefore, the examiner has failed to meet the burden imposed by MPEP 2112 with respect to claim 13 because the examiner has failed to present evidence or reasoning tending to show inherency. Claims 14-16 ultimately depend upon claim 13, and the same analysis applies to them.

2. Moreover, the '209 patent teaches an invention for "packaging carpet tiles." (See column 1, lines 13-14.) The '209 patent appears to bear no material relation to the present application except perhaps in that the '209 patent discloses "polyvinyl chloride," which may be contained in a carpet tile of the '209 patent, and the present application discloses polyvinyl chloride as a possible material of composition.

3. Claims 5-8, 13-16, and 22 stand rejected as anticipated by Ackley (USP 5,360,653) under 35 USC 102(b). Citing column 1, lines 5-7:

This invention relates to an encapsulated foam pad which may be used with furniture, as a leisure mat or as a mattress surface.

and column 1, line 53 through column 2, line 39:

A resilient panel for use as a body support comprising a first flexible sheet, a second flexible sheet and a plurality of resilient foam elements. The foam elements are of selected first sizes and possess selected

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compression ranges. The first sheet is conformed to include a plurality of expandable pockets, which are arranged longitudinally and transversely of the panel. The pockets are formed of selected second sizes which substantially correspond with the selected first sizes. The pockets are formed with an open upper area defined by an edge. Each of said resilient elements is located within a respective one of the pockets with which it is of substantially conforming size so that the resilient elements remain in an uncompressed condition. The second sheet is secured to the first sheet along the edge so that the foam elements are encapsulated within pockets. The arrangement allows the resilient panel to retain the maximum elastic capability of the resilient elements.

The panel may be of rectangular configuration or other suitable configuration and the pockets may be of selected configuration and prescribed depth. The prescribed depth may be variable or uniform. The selected pocket configuration may be uniform or variable. Also, the selected compression range may be uniform or variable between the resilient elements. When variable, the resilient elements are arranged throughout the panel according to a selected pattern. The pattern may have the interior portion of the panel with resilient elements being more compression resistant than the resilient elements arranged along the exterior portion of the panel.

The resilient elements are sized to be accommodated within the selected size of the pockets. The resilient elements may be formed so that those elements of larger size also have a greater resistance to compression than other of the resilient elements.

The panel may be arranged with its interior portion containing the larger size resilient elements.

The pockets of the panel may be arranged diagonally transversely and longitudinally of the panel.

The first and second sheets utilized to form the panel are normally either knitted or woven of natural fibers. Alternatively, they may be formed of synthetic material. The first and second sheets may be joined by bonding or stitching. A resilient panel is formed by providing a first sheet of material with a plurality of pockets. Resilient elements of a size corresponding to that of the pockets are placed in the pockets. A second sheet is arranged over and attached to the first sheet so that the foam elements are encapsulated within the pockets in an uncompressed manner. This arrangement allows the panel to retain compression potential equal the entire compression range of the elastic foam elements. Also, the

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arrangement allows compression of individual elastic foam elements without affecting adjacent elastic foam elements.

the examiner asserts that "The pad of the reference [sic] are considered to inherently possess the instantly claimed rolled up properties since the pad has the same structure that is instantly claimed." But neither citation supports the examiner's assertion.

First, claim 5 of the present application recites:

A floor mat, comprising:
a seamless user surface layer material; and
a cushion layer material bonded to said seamless user surface layer material, wherein the cushion layer material is segmented.

Neither citation of the '653 patent discloses or suggests "a seamless user surface layer material." By contrast, Figures 1-6 of the '653 patent disclose that the user surface has a plurality of expandable pockets. As such, the user surface is not seamless.

Moreover, neither citation of the '653 patent discloses or suggests "a cushion layer material bonded to said seamless user surface layer material, wherein the cushion layer material is segmented." By contrast, as shown in Figures 1-6, the user surface of the '653 patent is not bonded to the foam elements at all. Each foam element of the '653 patent is shown in Figures 1-6 to be encapsulated by an expandable pocket of the user surface.

Therefore, the examiner has failed to meet the burden imposed by MPEP 2112 with respect to claim 5 because the examiner has failed to present evidence or reasoning tending to show inherency. Claims 6-8 and 22 ultimately depend upon claim 5, and the same analysis applies to them.

Second, claim 13 of the present application recites:

A floor mat, comprising:
a seamless user surface layer material; and
a cushion layer material bonded to said seamless user surface layer material, wherein said cushion layer material is segmented;
wherein the floor mat is capable of being rolled into a roughly spiral configuration such that damages to the user surface layer material due to the tensile and compression forces on said seamless user surface layer material are minimal.

The above analysis applies equally to the first two elements of claim 13.

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In addition, neither citation of the '653 patent discloses or suggests "wherein the floor mat is capable of being rolled into a roughly spiral configuration such that damages to the user surface layer material due to the tensile and compression forces on said seamless user surface layer material are minimal." By contrast, the '653 patent does not disclose or suggest suitability for rolling. Indeed, the '653 patent teaches away from rolling. The '653 patent teaches the use of two flexible sheets: a first sheet and a second sheet. The first sheet includes a plurality of expandable pockets for encapsulating foam elements. Each pocket includes folds. At column 4, lines 19-21, the '653 patent teaches away from rolling of the encapsulated foam pad, because rolling would likely cause the pads to undergo compression or reformation: "folds 20 further ensure that elastic foam elements rest within pockets 10 in an uncompressed and unreformed condition."

Therefore, the examiner has failed to meet the burden imposed by MPEP 2112 with respect to claim 13 because the examiner has failed to present evidence or reasoning tending to show inherency. Claims 14-16 ultimately depend upon claim 13, and the same analysis applies to them.

4. Claims 9-12 and 21 stand rejected as obvious under 35 USC 103(a) based on Ackley (USP 5,360,653). The examiner asserts "The reference discloses the invention substantially as claimed; see column 1, lines 5-7 and column 1, line 53 through column 2, line 39. However, it does not disclose the claimed materials used for the surface layer and the cushion layer, or the amount of segments being claimed."

This assertion is critically flawed because the '653 reference does not disclose the limitations of claim 5, upon which claims 9-12 and 21 ultimately depend. As explained above, substantial differences exist between each of the pending claims and the '653 patent. Furthermore, those differences would not have been obvious to one having skill in the art. Therefore, the examiner's argument fails even if the additional elements of claims 9-12 and 21 were obvious.

However, the applicant does not believe that the additional elements of claims 9-12 and 21 are obvious. The examiner has not provided any authority to support that assertion, but has improperly based his assertion upon "common knowledge." Therefore, if the examiner insists

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upon maintaining his assertion that the additional limitations of claims 9-12 and 21 are obvious, the applicant demands under MPEP 2144.03 that the examiner support that assertion with documentary evidence.

For at least these reasons, it appears to the applicant that claims 9-12 and 21 are patentable.

5. Claim 21 stands rejected as obvious under 35 USC 103(a) based on Zybko et al. (USP 4,680,209). The examiner asserts:

The reference discloses the invention substantially as claimed; see column 3, lines 58-62 and column 5, lines 5-7[.] However, it does not disclose the amount [sic] of segments claimed. It would have been obvious to one of ordinary skill in the art to vary the amount of adhesive portions in the article of the reference depending on the desired size of the tile and the desired structural properties for a particular end use.

This assertion is critically flawed. As explained above, these citations of the '209 patent fail to disclose all of the elements of claim 5. The elements of claim 5 which are not disclosed by the '209 patent are nonobvious. Therefore, even if the additional elements of claim 21 were obvious based on the '209 reference, claim 21, as a whole, would still be patentable over the '209 reference.

Moreover, the applicant believes that the additional limitations of claim 21 are not obvious. To the extent that the examiner relies upon any claim of "common knowledge" to support a finding of obviousness of claim 21, the applicant asserts that the reliance is improper and demands the examiner produce documentary evidence in support of that obviousness assertion. See MPEP 2144.03.

Finally, it appears that the examiner has misunderstood claim 21 or the '209 patent because the examiner's obviousness assertion regarding varying the number of adhesive portions does not appear to have any relevance whatsoever to the present application. Rather, the '209 patent discloses the use of predetermined geometrical patterns that are complimentary so that when two tiles are placed back to back, the adhesive portions of one tile do not contact those of the other tile.

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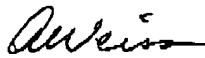
Applicant believes that the foregoing remarks/arguments fully respond to all outstanding matters for this application and respectfully requests that a timely Notice of Allowance be issued in this case.

Should the examiner question the allowability of any of the pending claims, the courtesy of a telephonic conference between the examiner, the examiner's supervisor, Harold Pyon, and the undersigned attorney at 512-469-6177 is respectfully requested. Alternatively, if the examiner has any questions or concerns that may be addressed by telephone, please do not hesitate to call.

Applicant believes that a 1-month extension fee of \$55.00 is due. The Commissioner is authorized to deduct from Thompson & Knight, LLP's Deposit Account No. 20-0821/077662.000008/AAW that fee and any additional fees required under Rules 1.16 -- 1.21 for any reason relating to the enclosed materials.

Respectfully submitted,

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MONTERREY, MEXICO**FAX RECEIVED****FACSIMILE COVER LETTER****TO:** U.S. Patent and Trademark Office**FAX NO.:** 703-872-9310**PHONE NO.:** 703-308-2421 (Examiner Alexander S. Thomas)**FROM:** Aaron A. Weiss (direct contact information is above)**SUBJECT:** Response to Office Action
Application No. 10/021,208

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DATE: June 30, 2003

CLIENT: Dollamur**OUR FILE NO.:** 077662.000008**NO. OF PAGES TO FOLLOW:** 10**PRIVILEGED & CONFIDENTIAL**

Commissioner:

This cover sheet accompanies a 10-page response to the office action mailed 2/28/2003. The following information identifies the corresponding application.

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Art Group: 1772
Examiner: Thomas, Alexander S.
1st Applicant: Gary Heartsfield
Filed: December 7, 2001
Title: Mat apparatus and method
Atty. Ref.: 077662.000008

Please call with any questions.

Respectfully submitted,



Aaron A. Weiss

USPTO Reg. No. 46,163

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